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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,216	07/14/2005	Wolfgang Clemens	411000.123	8754
27162 7590 09/06/2007 CARELLA, BYRNE, BAIN, GILFILLAN, CECCHI, STEWART & OLSTEIN 5 BECKER FARM ROAD ROSELAND, NJ 07068			EXAMINER WILSON, BRYAN E	
			ART UNIT 2891	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,216

Applicant(s)

CLEMENS ET AL.

Examiner

Bryan E. Wilson

Art Unit

2891

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :01/28/2005,
04/25/2005,08/31/2005,10/28/2005.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on July 29th, 2002. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,4, 10, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "predominantly" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "predominantly organic functional layers" or "predominantly organic material" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. Regarding claim 1, 4, and 10 the phrase "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
6. Regarding claim 4, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
7. Claim 13 provides for the use of the component, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Drury '024.

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a. Regarding claims 1 and 11, Drury discloses a vertical interconnect having at least one lower organic layer ('3' in e.g. fig. 4) and at least one central organic layer ('4' in e.g. fig. 4) coupled to a through-plating ('6' in e.g. fig. 4) that extends through the layers transversely to the layers and which through plating extends at least in part below at least one central functional layer, has non-sharp contours. Drury also discloses a polyamide substrate (substrate 2; see e.g. Fig. 4, col. 2 lines 24-26, and col.5 at line 60). The language, term, or phrase "prior to the application of the through plating to the at least one central functional layer the at least one lower functional layer is locally treated with the through plating", is directed towards the process of making an electronic component. It is well settled that "product by process" limitations in claims drawn to structure are directed to the product, per se, no matter how actually made. In re *Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, In re *Brown*, 173 USPQ 685; In re *Luck*, 177 USPQ 523; In re *Fessmann*, 180 USPQ 324; In re *Avery*, 186 USPQ 161; In re *Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re *Marosi et al.*, 218 USPQ 289; and particularly In re *Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or otherwise. The above case law further makes clear that applicant has the burden of showing that the method language necessarily produces a structural difference. As such, the language "whereby prior to" only requires one central

functional layer, one lower functional layer and through plating, which does not distinguish the invention from Drury, who teaches the structure as claimed.

b. Regarding claims 2-3, Drury further discloses that the through plating comprises a raised portion of electrically conductive material comprising polyaniline (layer 6 is an organically conducting material comprising polyaniline; see col. 1 lines 45-50, col. 2 lines 17-23, col. 4 lines 62-63, and col. 6 lines 6-33 and 55-58)

c. Regarding claim 4, Drury further discloses that the electronic component includes a non-conducting material (organic insulating area 5; see e.g. Fig. 4 and col. 4 line 62), with a central functional layer is a semiconductor material (see col. 6 lines 34-42)

d. Regarding claim 5, Drury further discloses that the through-plating (layer 6) is in the form of a raised portion that has a surface that contacts other layers (see Fig. 4)

e. Regarding claim 6, Drury discloses a lower functional layer as applied to claim 1 above. The language, term, or phrase “a chemical treatment”, is directed towards the process of making an electronic component. It is well settled that “product by process” limitations in claims drawn to structure are directed to the product, per se, no matter how actually made. In re *Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, In re *Brown*, 173 USPQ 685; In re *Luck*, 177 USPQ 523; In re *Fessmann*, 180 USPQ 324; In re *Avery*, 186 USPQ 161; In re *Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re *Marosi et al.*, 218 USPQ 289; and particularly In re *Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product,

whether claimed in “product by process” claims or otherwise. The above case law further makes clear that applicant has the burden of showing that the method language necessarily produces a structural difference. As such, the language “the electronic component” only requires a lower functional layer, which does not distinguish the invention from Drury, who teaches the structure as claimed.

f. Regarding claim 7, Drury discloses a lower functional layer as applied to claim 1 above. The language, term, or phrase “a physical treatment”, is directed towards the process of making an electronic component. It is well settled that “product by process” limitations in claims drawn to structure are directed to the product, per se, no matter how actually made. In re *Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, In re *Brown*, 173 USPQ 685; In re *Luck*, 177 USPQ 523; In re *Fessmann*, 180 USPQ 324; In re *Avery*, 186 USPQ 161; In re *Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re *Marosi et al.*, 218 USPQ 289; and particularly In re *Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or otherwise. The above case law further makes clear that applicant has the burden of showing that the method language necessarily produces a structural difference. As such, the language “the electronic component” only requires a lower functional layer, which does not distinguish the invention from Drury, who teaches the structure as claimed.

g. Regarding claim 8, Drury further shows a disruption on the lower layer (see e.g. Fig. 4; the layer is disrupted such that it is not continuous)

h. Regarding claim 9, Drury further discloses a lower functional layer as applied to claim 1 above. The language, term, or phrase “a preceding locally restricted change in the surface energy of the at least one lower functional layer, at which no wetting by a subsequently applied organic material of a subsequent central functional layer occurred”, is directed towards the process of making an electronic component. It is well settled that “product by process” limitations in claims drawn to structure are directed to the product, per se, no matter how actually made. In re *Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, In re *Brown*, 173 USPQ 685; In re *Luck*, 177 USPQ 523; In re *Fessmann*, 180 USPQ 324; In re *Avery*, 186 USPQ 161; In re *Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re *Marosi et al.*, 218 USPQ 289; and particularly In re *Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or otherwise. The above case law further makes clear that applicant has the burden of showing that the method language necessarily produces a structural difference. As such, the language “the electronic component” only requires a lower layer and central layer, which does not distinguish the invention from Drury, who teaches the structure as claimed.

i. Regarding claim 10, Drury further discloses a lower functional layer as applied to claim 1 above. The language, term, or phrase “produced locally on...by application of a material, at which prior to or after application of one of the central functional layers the dislocation can be detected by at least one of material residue...”, is directed towards the process of making an electronic component. It is well settled that “product by process” limitations in claims drawn to structure are directed to the product, per se, no matter how actually made. In re *Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, In re *Brown*, 173 USPQ 685; In re *Luck*, 177 USPQ 523; In re *Fessmann*, 180 USPQ 324; In re *Avery*, 186 USPQ 161; In re *Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re *Marosi et al.*, 218 USPQ 289; and particularly In re *Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or otherwise. The above case law further makes clear that applicant has the burden of showing that the method language necessarily produces a structural difference. As such, the language “an electronic component” only requires a lower functional layer, which does not distinguish the invention from Drury, who teaches the structure as claimed.

j. Regarding claim 13, Drury further discloses that the component can be used as a field-effect transistor and implemented in circuits for use as an frequency dividers and ring oscillators (see e.g. col. 4 lines 17-27)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ezawa '839 as provided in the Information Disclosure Statement submitted on April 25th, 2005 and further in view of Drury '024.

a. Ezawa discloses a process for forming at least one through-plating (metal pillar 11; see e.g. Fig. 2) of an electronic component comprising material and an insulating layer, wherein the through plating is formed prior to the application of the insulating layer (see e.g. Figs 1-2).

Ezawa fails to disclose that the material is organic material. However, Drury discloses an electrical component in which several of the layers are made of organic material (see e.g. col. 6 at lines 34-43). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used organic materials as taught by

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Drury in the method of Ezawa so as to provide solution processable materials which can be applied through spin-coating and thereby reduce processing costs.

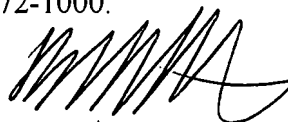
Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DeLeeuw '406 discloses a vertical interconnect structure comprising organic materials. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan E. Wilson whose telephone number is (571) 270-1568. The examiner can normally be reached on Monday through Friday 8:00am-4:30pm E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Baumeister can be reached on (571)272-1722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BW
08/29/2007


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